REMARKS/ARGUMENTS

This patent application currently includes claims 1-29, all of which stand rejected. All rejections are respectfully traversed.

Claims 1-29 were rejected as obvious over WO 99/28850 (White) in view of Blagg U.S. published patent application number US 2002/0198806 (Blagg). This rejection is respectfully traversed. Neither reference nor that combination renders the present claims obvious.

MPEP §2142 provides, in relevant part, that:

> The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

"To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). In the present instance, the examiner has demonstrated neither and, therefore, has not met the burden of establishing a *prima facie* case of obviousness.

Initially, the undersigned objects to the Examiner's approach to making the obviousness rejections in the present instance. The following is exemplary:

> Blagg discloses that the user may set usage parameters and that these usage parameters are not limiting (p.1, 7). The user may set up parameters to allow for only delivery of

> the purchase to the specific property to prevent theft.

Apparently, the examiner has overlooked the requirement that for references to be combined, "there must be some reason, suggestion or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge cannot come from the applicants' invention itself." *In Re Oetiker*, 24 U.S.P.Q. 2d 1443 (Fed. Cir. 1992).

In particular, "The mere fact that the prior art may be modified in the manner suggested by the examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." *In re Fritch*, 23 U.S.P.Q. 2nd 1780, 1783 (Fed Cir. 1992). This is especially true where, as the examiner admits in the present instance, the reference discloses al large or unlimited number of alternatives. What is the motivation for selecting a particular one, other than the disclosure of the present patent application?

The fact that the examiner has not cited to any prior art is telling. Apparently, she has not been able to find any prior art that even remotely suggests the present convention. It is possible, however, that she is basing this rejection upon personal knowledge. If that is the case, the applicant calls upon the examiner to submit an affidavit pursuant to 37 CFR §1.104(d)(2), which shall be subject to contradiction or explanation by the affidavits of appropriate experts. In the absence of such an affidavit, it must be assumed that the examiner's rejections are based entirely upon the present record, and they must fail, as explained further below.

Independent claims 1, 6, 11, 17 and 29 (and claims dependent from them) relate to a "property linked-credit card." In each case, use of the card is limited in relationship to the property. For example, according to claim 1, a purchase must be

delivered to the property; and according to claims 6, 11, 17 and 29 the user must establish possessory authority over the property in order to be able to complete the transaction. In each case, use of the card is somehow limited by the property.

The applicant has given the examples of the utility and benefit, of such a card and the associated system. As exemplified above, the examiner has merely cited a system which was making use of cards and disclosing broad parameters for their application, none of which even remotely suggests the present convention. Such an "obvious to try" approach is not an appropriate basis for an obvious is rejection. *In re Roemer*, 59 USPQ2d 1537 (Fed. Cir. 2001); *In re Deuel*, 34 USPQ2d 1210 (Fed. Cir. 1995).

In summary, the record is entirely devoid of any prior a basis even remotely suggesting that the completion of a transaction with a credit card should be limited to delivery to a specified property or by demonstrating possessory authority over the property. Moreover, this provides a substantial benefit. Therefore, had it been obvious, it certainly would have been done by those skilled in the art. The fact that the examiner has been unable to find any prior art support, but merely bases these rejections upon hand waiving is just further evidence of their impropriety.

All obviousness rejections should be withdrawn, and all claims presently in this application should be allowed in their present form.

It is respectfully requested that the present amendment be entered, because it places the present application in better condition for allowance or appeal. Moreover, although does is cancel the last group of claims, which the applicant is entitled to do.

In view of the above, each of the presently pending claims in this application is believed to be in immediate

condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue.

If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that he/she telephone applicant's attorney at (908) 654-5000 in order to overcome any additional objections which he might have.

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

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Respectfully submitted,

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